

REMARKS/ARGUMENTS

Status of Claims

Claims 1-55 are pending in the application.

Claims 1, 6, 7, 15, 46, and 53 are hereby amended.

Claim 56 is a new claim.

Applicants hereby request further examination and reconsideration of the presently claimed application.

Allowable Subject Matter

Applicants note with appreciation the indication that claims 6, 7, 24-31, 33, 36, 39-41, and 51 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants have rewritten and submitted claims 6 and 7 in independent form including all of the limitations of the base claim and any intervening claims. Accordingly, claims 6 and 7 are now allowable. New claim 56 has been added to further define the invention. More particularly, new claim 56 relates to the types of devices described in the specification that may be employed to control the temperature of energy storage devices. New claim 56 is analogous to allowable amended claims 6 and 7. No new matter is contained in new claim 56.

Amendments to Drawings

The Office Action requires new corrected drawings in this application to correct the designation of the reference character "110" in the initially submitted drawings. In response to this requirement, the Applicants submit herewith one (1) replacement sheet of Figure 10 in compliance with 37 C.F.R. § 1.84 which correct the informalities noted in the Office Action. Acceptance of the Replacement Drawing submitted herewith is respectfully requested.

Amendments to Specification

Pursuant to the above-described submission of replacement figures in compliance with 37 C.F.R. § 1.84, paragraph [0032] of the Specification is amended to reflect that the “subterranean formation” depicted in Figure 10 is designated as reference character “111.” No new matter is contained in this amendment.

Claim Rejections – 35 USC § 102

The Office Action rejected claims 1-5, 8-23, 32, 34, 35, 37, 38, 42-50, and 52-55 under 35 USC § 102(b) as being anticipated by *Scherbatskoy* (U.S. 4,416,000). As explained by the Court of Appeals for the Federal Circuit: “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegall Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Amended claim 1 reads:

1. A method of preparing an energy storage device for powering a downhole tool, comprising: heating an energy storage device to an effective temperature to improve operability of the energy storage device, wherein the heat used to heat the energy storage device is a product of a non-electrically powered process or a byproduct of an electrically powered process.

Amended claim 46 is subject to similar limitations. Support for the amending language can be found in the specification. *See, e.g.*, Application paragraph [0020] (“[A]n embodiment is depicted in which reactants being fed to an acid fuel cell 22 are pre-heated by heat generated by the fuel cell itself.”); paragraph [0024] (“[O]ne or both feed lines 14 and 16 are heated by waste heat generated by electrical load 34, which may power a downhole tool such as a transmitter.”); paragraph [0032] (“A magnetic field generator 116 may be placed within casing 114 that includes a ferromagnetic core 118 and electromagnetic coils 120. A current may be passed down from the surface of the earth via electrical line 122 and through electromagnetic coils 120, thereby

generating a magnetic field for heating a battery 126 positioned outside of casing 114.”); and paragraph [0033] (“Another heat source is waste heat from a refrigeration system used to cool downhole components such as the electronics of a downhole tool.”). Dependent claims 15 and 53 were amended to recite “non-electrically powered” heater which is consistent with the scope of amended claims 1 and 46. *Scherbatskoy* does not teach the limitations contained in the amending language of claims 1, 15, 46, and 53.

The Office Action recites that *Scherbatskoy* discloses a method of preparing an energy storage device for powering a downhole tool comprising, in part: “the energy storage device heated using heat generated by the discharge of the energy storage device” Office Action at 3. This characterization of *Scherbatskoy*’s disclosure, while superficially correct, does not capture the actual processes described in 4,416,000; therefore, reliance on this statement as a basis for rejecting portions of the instant application is misplaced. A careful parsing of the text of 4,416,000 reveals *Scherbatskoy*’s teaching with respect to the above-referenced element is limited to “heat generated by [the heating element powered by the electric current produced by] the discharge of the energy storage device.” Compare Office Action at 3 with *Scherbatskoy* Col. 3, lines 43-44 (“reference numeral 156 designates heating elements that are arranged to provide a small amount of heating to the battery”) and Col. 4, line 67 – Col. 5, line 2 (“applying voltage from the battery to the associated heating means to heat the battery while in the borehole to maintain the temperature of the battery to an appropriate operating temperature”). Unlike the teachings of the instant Application, the heat produced pursuant to *Scherbatskoy*’s teaching is the intended or primary product of the disclosed electrically powered process of applying voltage to heating elements to melt the electrolyte. See *Scherbatskoy* Col. 3, lines 50-54.

Based on the foregoing, *Scherbatskoy* does not teach the use of heat generated as a product of a non-electrically powered process or as a byproduct of electrically powered process as a method of heating energy storage devices. Specifically, *Scherbatskoy*'s teachings are limited to the use of electrically powered heat sources (e.g. heat sources that convert electric current directly to heat energy) as a means of heating energy storage devices to improve their operability. Thus, the pending claims contain an element, or elements, not present in *Scherbatskoy*. Accordingly, the pending claims should be allowed as they are not anticipated by *Scherbatskoy*.

Claim Rejections – 35 USC § 103

The Office Action rejected claims 9, 14, 16, 19, 20, 42, 43, and 48 under 35 USC § 103(a) as being unpatentable over *Scherbatskoy* in view of *Blake* (U.S. 4,314,008). The Office Action rejected claims 12, 49, and 50 under 35 USC § 103(a) as being unpatentable over *Scherbatskoy* in view of *Ashtiani* (U.S. 6,259,229). The Office Action rejected claim 13 under 35 USC § 103(a) as being unpatentable over *Scherbatskoy* in view of *Ashtiani* (U.S. 6,259,229) and in further view of *Reiss* (U.S. 4,692,363). The Office Action rejected claims 21-23 and 32 under 35 USC § 103(a) as being unpatentable over *Scherbatskoy* in view of *VanBerg, Jr.* (U.S. 5,202,194). Thus, claims 9, 12, 13, 14, 16, 19-23, 32, 42, 43, 48, 49, and 50 stand or fall on the application of *Scherbatskoy* to the claims.

The requirements for establishing a *prima facie* case of obviousness are well established:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicants' disclosure. MPEP § 2142 citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added).

As explained in reference to the § 102(b) rejections above, *Scherbatskoy* fails to teach or suggest the limitations contained in amended claims 1, 15, 46, and 53. In addition, all dependent claims incorporate the limitations of the claims they depend on. Because claims 9, 12, 13, 14, 16, 19-23, 32, 42, 43, 48, 49, and 50 depend on and; therefore, incorporate the limitations of amended claims 1, 15, 46, and 53, and *Scherbatskoy* fails to teach the limitations of amended claims 1, 15, 46, and 53, *Scherbatskoy* also fails to teach or suggest the limitations contained in claims 9, 12, 13, 14, 16, 19-23, 32, 42, 43, 48, 49, and 50. The Office Action does not cite the remaining prior art references to teach the limitations that are absent from *Scherbatskoy*. Thus, the Office Action does not establish a *prima facie* case of obviousness as to claims 9, 12, 13, 14, 16, 19-23, 32, 42, 43, 48, 49, and 50, which are allowable over the cited prior art.

CONCLUSION

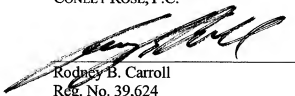
Consideration of the foregoing amendments and remarks, reconsideration of the application, and withdrawal of the rejections and objections are respectfully requested by Applicants. No new matter is introduced by way of the amendment. It is believed that each ground of rejection raised in the Office Action dated June 21, 2006 has been fully addressed. If any fee is due as a result of the filing of this paper, please appropriately charge such fee to Deposit Account Number 50-1515 of Conley Rose, P.C., Texas. If a petition for extension of time is necessary in order for this paper to be deemed timely filed, please consider this a petition therefore.

If a telephone conference would facilitate the resolution of any issue or expedite the prosecution of the application, the Examiner is invited to telephone the undersigned at the telephone number given below.

Respectfully submitted,
CONLEY ROSE, P.C.

Date:

9-12-06



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